

Serial No. 09/944,175

Docket No. Q65952

REMARKS

Claims 1, 2, 4-8 and 10-22 are all the claims pending in the application. By this Amendment, claims 1, 4, 10, 11 and 22 are amended, and claims 3 and 9 are cancelled without prejudice or disclaimer. Applicant respectfully submits that because the amendments merely incorporate dependent claims into the independent claim, no new search or consideration is required. For at least the reasons herein, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

Applicant thanks the Examiner for withdrawal of the 35 U.S.C. § 112, 1st and 2nd paragraph rejections. Applicant submits that the prior art rejections should also be withdrawn for at least the reasons discussed below.

I. The claims are novel

Claims 1-8, 12-18 and 22 stand rejected under 35 U.S.C. § 102(b) over Ullman et al. (U.S. Patent No. 6,103,537, hereafter "Ullman"). Applicant respectfully submits that Ullman fails to disclose all of the claimed features, as required for an anticipation rejection. For at least the reasons herein, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

Applicant respectfully submits that Ullman fails to disclose that the probes are spotted on the substrate and fixed thereon, and the respective captured targets are electrophoresed, thereby being fractionated, as recited in independent claim 1. Applicant submits that Ullman makes no disclosure of the spotting of the probes on the substrate.

Serial No. 09/944,175

Docket No. Q65952

Further, Applicant respectfully submits that dependent claims 2-8, 12-18 and 22 are also novel over Ullman, due to their dependency from independent claim 1. Therefore, Applicant respectfully requests withdrawal of the anticipation rejection, and allowance of the claims.

II. The claims would not have been obvious

Claims 1, 2 and 9-21 stand rejected under 35 U.S.C. § 103(a) over the Examiner's proposed combination of Alfenito (U.S. Patent No. 6,355,419B1) in view of Ichie (U.S. Patent No. 5,796,112). Applicant respectfully submits that the Examiner's proposed combination fails to teach or suggest all of the claimed features, as required for an obviousness rejection. For at least the reasons herein, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

Applicant respectfully submits that the proposed combination of references fails to disclose or suggest all of the claimed combinations of features. For example, but not by way of limitation, Applicant respectfully submits that the proposed combination of references fails to teach or suggest the probes are spotted on the substrate and fixed thereon, and the respective captured targets are electrophoresed, thereby being fractionated, as recited in independent claim 1.

At column 14, lines 50-54, Alfenito discloses distinguishing between adjacent and non-adjacent probes. However, Applicant respectfully submits that the detection of Alfenito does not correspond to only detecting the fractionated target, and does not disclose or even suggest that the samples are one-dimensionally or two-dimensionally spotted to form a plurality of spots. Further, the sequence of labeling with respect to binding and fractionating is not believed to be

Serial No. 09/944,175

Docket No. Q65952

disclosed. Therefore, it is not disclosed whether fractionating of the captured targets can be performed by electrophoresis. With respect to the labeling, Applicant respectfully submits that the timing of labeling is not disclosed with respect to binding and fractionating.

Applicant respectfully submits that the proposed combination of references does not disclose or suggest that the respective captured targets are fractionated via electrophoresis, as recited in independent claim 1. With respect to the spotting of the probes recited in independent claim 1, Applicant respectfully submits that the proposed combination is improper for at least the reasons discussed below.

Claims 2 and 10-21 depend from independent claim 1. Applicant respectfully submits that the dependent claims are allowable for at least the same reasons as the independent claims from which they depend. Additionally, Applicant respectfully submits that the proposed combination of references fails to disclose or suggest that the target is labeled prior to binding, as recited in claims 14 and 17, or that the target is labeled after fractionating, as recited in claim 15. Applicant notes that the cited art of record does not specifically teach or suggest the claimed sequence of steps.

The Examiner acknowledges that the references do not specifically disclose these claimed features, and proposes to cure the acknowledged deficiencies of the combination by asserting that whether the labeling occurs before binding or after fractionating is an experimental design choice, and is therefore considered within the purview of the prior art. For at least the reasons herein, Applicant respectfully disagrees.

Applicant notes that the fact that a reference *can* be modified is not sufficient to establish a prima facie obviousness rejection, see MPEP § 2143.01. Further, Applicant submits that there

Serial No. 09/944,175

Docket No. Q65952

is no suggestion to perform the binding in the claimed sequence, except for the motivation provided by the specification supporting the claimed invention. Such a source of motivation is improper for a prima facie obviousness rejection.

Further, Applicant respectfully submits that the Examiner has made a factual assertion without proper support. Therefore, Applicant respectfully requests that the Examiner provide concrete evidence in support of the assertion that the order of the claimed steps is an experimental design choice.

Therefore, Applicant respectfully requests withdrawal of the obviousness rejection, and allowance of the claims.

Serial No. 09/944,175

Docket No. Q65952

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Chid S. Iyer
Registration No. 43,355

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 7, 2003